REMARKS

I. General

Claims 1-8 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1-13, 15, and 17-29 stand rejected under 35 U.S.C. § 103(a). Claims 1-13 and 15-29 are pending in this application.

II. Allowable Subject Matter

The Examiner has not specifically rejected claim 16. Therefore, Applicant assumes claim 16 contains allowable subject matter.

III. The 35 U.S.C. § 112 Rejections

Claims 1-8 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because of the Examiner's contention that the term "agent" does not appear in the specification. Applicant refers Examiner to original claims 13-18, which describe an "agent" as used in claims 1-8. MPEP 608.01(l) clearly states that the original claims are part of the disclosure and as such satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. Thus in view of claims 13-18 at the time the application was filed, Applicant had possession of the claimed invention. Therefore, Applicant respectfully requests the 35 U.S.C. § 112, first paragraph, rejection be withdrawn.

IV. The 35 U.S.C. § 103 Rejections (Pepe)

Claims 1-2, 4-6, 8-11, 13, 15, 17, and 19-29 stand rejected under stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe et al. (5,742,905, hereinafter Pepe).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Applicant asserts that the rejections do not satisfy the first and third criteria.

Lack of All Limitations

Claims 1 and 5 define an agent adapted to compare characteristics of e-mail messages received for the subscriber to specific message characteristics provided by the subscriber and pre-stored on the server, to alert the subscriber when a characteristic match is found, and to execute instructions received from the subscriber in response to the alert. Pepe does not disclose at least these limitations.

The Office Action at page 2 admits that Pepe does not disclose the limitations of claims 1 and 5 regarding email, then alleges the limitations are obvious in view of Pepe through the operation of CallCommand directed to voicemail. Applicant respectfully disagrees with Examiner's characterization of Pepe. Regarding voicemail, Pepe column 27, line 13 to column 28, line 52 clearly defines the services for voicemail as screening the message, selectively forwarding the message, and notifying subscriber (paralleling the services for email), but does not include executing instructions in response to the alert. The active forwarding functionality referenced by the Examiner refers only to voice calls and not to messages (column 29, lines 27-29), as required by claims 1 and 5. Thus, Pepe does not disclose all the limitations of claim 1 and 5. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 1 and 5 are patentable over Pepe and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

Claim 9 defines a method comprising receiving instructions for forwarding stored messages from a subscriber in response to an alert and forwarding the stored messages for which a match is found to destinations according to the instructions provided in response to the alert. Claim 13 defines an agent comprising a save facility adapted for storing matched messages against future distribution instructions, the future distribution instructions received from a subscriber in response to an alert. Claim 19 defines a method comprising receiving a reply from a subscriber in response to an alert, the reply comprising instructions for a message and processing the message according to the instructions.

As discussed above in the response to the rejections of claims 1 and 5, Pepe does not disclose at least these limitations. Specifically, Pepe does not disclose: forwarding stored messages for which a match is found to destinations according to the instructions provided in

response to the alert; storing matched messages against future distribution instructions, the future distribution instructions received from a subscriber in response to an alert; and receiving a reply from a subscriber in response to an alert, the reply comprising instructions for a message and processing the message according to the instructions. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 9, 13, and 19 are patentable over Pepe and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

Lack of Motivation

The Examiner has stated that it would be obvious to modify Pepe for use with email messages. As stated above Pepe does not respond to instructions for messages, only for voice calls. Even so, Applicant respectfully asserts that the Examiner is using the present application as a blueprint for the obviousness contention. Impermissible hindsight may not be used in a conclusion of obviousness and as such, knowledge gleaned only from Applicant's disclosure may not be used, see MPEP 2145, paragraph X.A. and *In re McLaughlin*. Applicant respectfully asserts that Examiner's conclusion of obviousness is based on improper hindsight reasoning, in that acting in response to a voicemail notification (i.e., reading CallCommand features for voice calls onto voicemail) is knowledge gleaned only from Applicant's disclosure. Thus, Applicant respectfully asserts that the 35 U.S.C. § 103(a) rejection of claims 1, 5, 9, 13, and 19 is improper. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 1, 5, 9, 13, and 19 have been improperly rejected over Pepe and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

Claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 each depend directly or indirectly from one of independent claims 1, 5, 9, 13, or 19 and inherit all the features and limitations of their respective base claim. Thus, claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 each set forth features and limitations not found in Pepe and were improperly rejected, as discussed above. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 2, 4, 6, 8, 10-11, 15, 17, and 20-29 are patentable over Pepe and requests the 35 U.S.C. § 103(a) rejection be withdrawn.

V.   The 35 U.S.C. § 103 Rejections (Pepe in view of Fuller)

Claims 3, 7, 12, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe in view of Fuller et al. (6,545,589).

Claims 3, 7, 12, and 18 each depend directly or indirectly from one of independent claims 1, 5, 9, or 13 and inherit all the features and limitations of their respective base claim. Thus, claims 3, 7, 12, and 18 each set forth features and limitations not found in Pepe, as discussed above. Fuller is not relied upon as teaching these limitations. Further, claims 3, 7, 12, and 18 were improperly rejected, as discussed above. Therefore, Applicant respectfully asserts that for at least the above reasons, claims 3, 7, 12, and 18 are patentable over Pepe in view of Fuller and requests the 35 U.S.C. § 103(a) rejection be withdrawn.
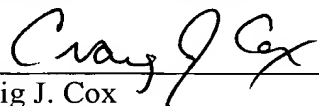
CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 66360/P001D1/10402620 from which the undersigned is authorized to draw.

Dated: December 9, 2005   Respectfully submitted,

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